

REMARKS

Claims 1-19 have been examined. Claims 18 and 19 have been rejected under 35 U.S.C. § 112, second paragraph, claims 1-5 and 8-11 have been rejected under 35 U.S.C. §102(b), and claims 12-19 have been rejected under 35 U.S.C. § 103(a). Also, the Examiner has indicated that claims 6 and 7 contain allowable subject matter.

Preliminary Matters

In the April 2, 2004 Amendment, Applicant submitted three sheets of replacement drawings. The Examiner has indicated that under 37 C.F.R. § 1.121(d), Applicant is required to submit a marked up copy of each Replacement Sheet including annotations. Applicant notes that 37 C.F.R. § 1.121(d)(1) does not require both replacement sheets and annotated drawings. Rather, under 1.121(d)(1), the rules state that the changes to the drawings, "shall be explained, in detail, in **either** the drawing amendment or **remarks section of the paper.**" (emphasis added) However, as set forth under 37 C.F.R. § 1.121(d)(2), annotated drawings must be submitted when specifically required by the Examiner.

Accordingly, Applicant is submitting annotated figures with the added text of each box marked in pink highlighter.

Rejections under 35 U.S.C. § 112, second paragraph

The Examiner has rejected claims 18 and 19 under 35 U.S.C. §112, second paragraph, as being indefinite. Applicant submits that amended claims 18 and 19 comply with the requirements of 35 U.S.C. § 112, second paragraph, and respectfully requests the Examiner to withdraw the rejection.

Rejections under 35 U.S.C. § 102(b)

Claims 1-5 and 8-11 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,809,128 to McMullin (“McMullin”)

A. Claim 1

Applicant submits that claim 1 is patentable over the cited reference. For example, claim 1 recites a method of activating an inactive terminal. The method involves making a telephone call from a server of the data network, through the telephone network, to the terminal to be activated. The server later terminates the telephone call to the terminal. A connection is then established from the terminal to be activated to the data network.

The Examiner maintains that McMullin discloses the above features. In particular, the Examiner maintains that the called party proxy 38 discloses the claimed server, and the subscriber 28 discloses the claimed terminal to be activated (Fig. 2; col. 8, lines 12-24). Figure 2 of McMullin relates to a call forwarding service. If the subscriber 28 is currently on the phone, or the internet, a call is forwarded to the proxy 38 for proper processing (col. 8, lines 35-65). Accordingly, contrary to the recitation of claim 1, the alleged terminal (i.e. subscriber 28) is

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already “activated.” As stated above, the proxy 38 merely notifies the subscriber of the further incoming calls, or for messages.

One example of a service provided by the proxy 38 is disclosed in column 11 of McMullin. The subscriber’s computer can be equipped with audio equipment for use with a voice audio input path (col. 11, lines 28-37). The proxy 38 is also equipped with the appropriate software and hardware to connect a caller with the sound equipment (col. 11, lines 38-40). Once the proxy 38 informs the subscriber 28 of an incoming call, the subscriber 28 informs the proxy 38 of an intention to carry out the telephone conversation using the internet (col. 11, lines 40-44). The proxy 38 then establishes the necessary connection to connect the caller to the subscriber over a message path (col. 11, lines 44-48). Such process is performed without disconnecting the subscriber from the data service that was being used when the caller initially was routed to the proxy (col. 11, lines 48-50).

On page 4 of the Office Action, the Examiner refers to the above example as disclosing the claimed, “establishing a connection from the terminal (6) to be activated to the data network (1) if the signaling indicates that the telephone call came from a server (11) of the data network (1).” However, as set forth in claim 1, prior to establishing the connection, the server terminates the telephone call to the server. There is no disclosure that the proxy (i.e. alleged server) terminates the call to the subscriber (i.e. alleged terminal) before the caller is patched through for voice signaling over the internet. Further, since the subscriber is already connected to the internet, there is no establishment of a connection needed. For example, as specifically recited in

the reference, a message path is bridged between the call and the subscriber, “all without disconnecting the subscriber from the data services he or she was using.” (col. 11, lines 45-50).

In summary, contrary to the present invention, McMullin assumes that a subscriber is engaged in using an existing data connection over his telephone line and cannot be reached by telephone. The server uses the existing data communication to alert the subscriber and to announce a waiting phone call or message.

Based on the foregoing, Applicant submits that McMullin fails to teach or suggest the method recited in claim 1.

B. Claims 2-5

Since claims 2-5 are dependent upon claim 1, Applicant submits that such claims are patentable at least by virtue of their dependency.

C. Claims 8-11

Since claim 8 contains features that are analogous to the features recited in claim 1, Applicant submits that claim 8 is patentable for at least analogous reasons as claim 1.

D. Claims 9-11

Since claims 9-11 are dependent upon claim 8, Applicant submits that such claims are patentable at least by virtue of their dependency.

Rejections under 35 U.S.C. § 103(a)

The Examiner has rejected claims 12-19 under 35 U.S.C. § 103(a) as being unpatentable over McMullin in view of U.S. Patent No. 6,085,080 to Rahikainen et al. (“Rahikainen”).

A. Claim 12

Applicant submits that claim 12 is patentable over the cited references. For example, claim 12 recites that an adaptor unit is connected between a terminal and a telephone network.

The Examiner refers to Fig. 2 of McMullin and appears to maintain that the subscriber’s computer 35 discloses the claimed adaptor unit. It also appears that the Examiner maintains that the subscriber 28 discloses the claimed terminal. However, as shown in Fig. 2, the computer 35 is not connected between the subscriber 28 and the telephone network 40. Rather, the computer 35 forms a part of the subscriber 28. There is no additional unit, i.e. an adaptor unit, connected between subscriber 28 and the telephone network 40.

Claim 12 further recites that the adaptor unit has means for retrieving and/or receiving a data network address of a further adaptor unit from the server of the data network.

Even if Applicant assumes *arguendo* that computer 35 discloses the claimed adaptor unit, the reference fails to teach or suggest a “further” computer provided with the second caller’s telephone 44a.

Since Rahikainen fails to cure the deficient teachings of McMullin, as set forth above, Applicant submits that claim 12 is patentable over the cited references.

B. Claims 13 and 14

Since claims 13 and 14 are dependent upon claim 12, Applicant submits that such claims are patentable at least by virtue of their dependency.

C. Claim 15

Applicant submits that claim 15 is patentable over the cited reference. For example, claim 15 recites that an adaptor unit is provided “in” a telephone.

As stated above, it appears that the Examiner maintains that the computer 35 of McMullin discloses the claimed adaptor unit. However, McMullin fails to teach or suggest that the computer 35 is incorporated “in” the telephone 34a (Fig. 2).

Since Rahikainen fails to cure the deficient teachings of McMullin, as set forth above, Applicant submits that claim 15 is patentable over the cited references.

D. Claim 16

Applicant submits that claim 16 is patentable over the cited references. For example, claim 16 recites that a data network address of a further adaptor unit is retrieved.

As stated above in Applicant’s comments regarding claim 12, McMullin fails to teach or suggest a further adaptor unit.

Since Rahikainen fails to cure the deficient teachings of McMullin, Applicant submits that claim 16 is patentable over the cited references.

E. Claim 17

Since claim 17 is dependent upon claim 16, Applicant submits that such claim is patentable at least by virtue of its dependency.

F. Claim 18

Similar to claim 1, claim 18 is directed to a method of activating an *inactive* terminal. As stated above in Applicant's comments regarding claim 1, the alleged terminal (i.e. subscriber 28) of McMullin is already activated. The alleged server (i.e. proxy 38) merely notifies the subscriber 28 of the further incoming calls or messages.

Since Rahikainen fails to cure the deficient teachings of McMullin, Applicant submits that claim 18 is patentable over the cited references.

G. Claim 19

Since claim 19 contains some features that are analogous to the features recited above for claim 12, Applicant submits that claim 19 is patentable for at least analogous reasons as claim 12.

Allowable Subject Matter

As stated above, the Examiner has indicated that claims 6 and 7 contain allowable subject matter.

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Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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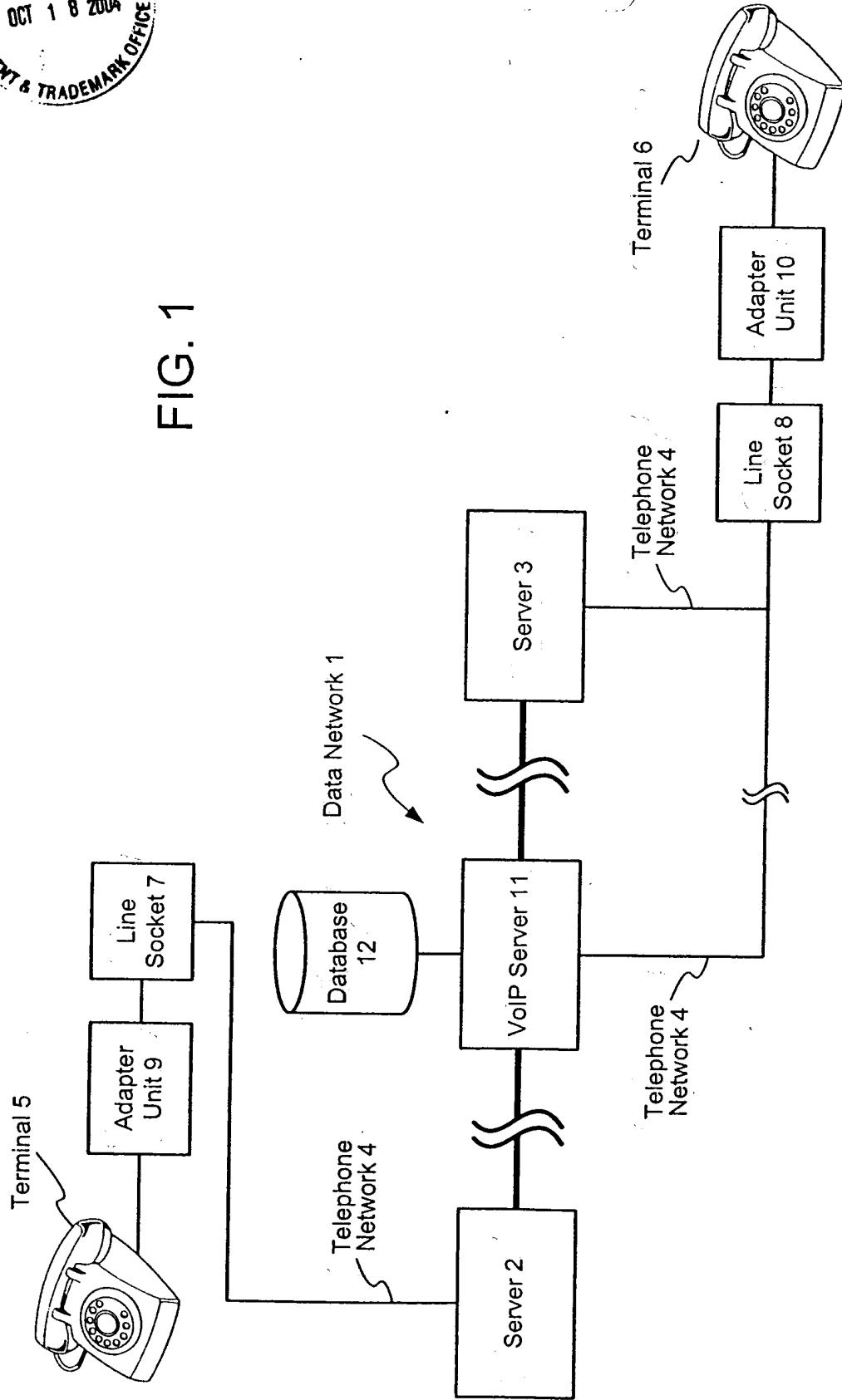
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CUSTOMER NUMBER



FIG. 1

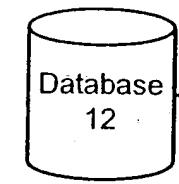




Annotated Drawings
U.S. Application No.: 09/676,675
Inventor: Frank HAGEBARTH
Group Art Unit: 2662
Sheet 2 of 3



Calling Party
Terminal 5



Called Party
Terminal 6

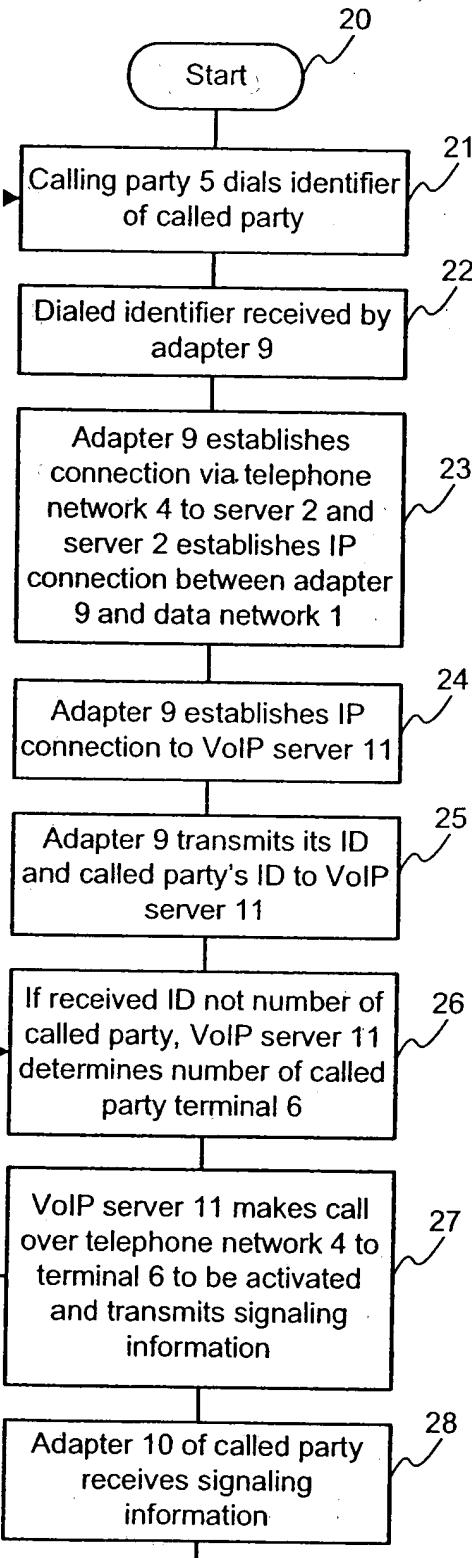


FIG. 2A

FIG. 2B

FIG. 2A

